Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte J. ROBERT SIMS and KYLE WAY

Appeal No. 2003-0976
Application No. 09/753,372

ON BRIEF

Before FLEMING, RUGGIERO, and MACDONALD, ***Administrative Patent Judges***.

MACDONALD, ***Administrative Patent Judge.***

REMAND TO THE EXAMINER

We remand this application to the Examiner for consideration of the following matters.

I. Whether a rejection of claims 1-40 under 35 U.S.C. § 112 is appropriate.

II. Whether a rejection of claims 1-14, 25-37, and 39-40 under 35 U.S.C. § 112 is appropriate.

III. Whether a rejection of claims 15-24 and 38 under 35 U.S.C. § 112 is appropriate.

IV. Whether a rejection of any of claims 1-40 under 35 U.S.C. § 101 is appropriate.

I. Whether A Rejection Of Claims 1-40 Under 35 U.S.C. § 112 Is Appropriate.

Independent claims 1, 15, 35, and their dependent claims recite or depend from claims that recite the word "parameter" multiple times. We have reviewed Appellants' disclosure and find that the word "parameter" is used to mean two different things in the specification. At page 9, lines 9-11, the word "parameter" refers to "the spare interval (SI) and the spare length (SL)." This appears to be a well recognized usage of the word "parameter" to mean a "variable." However, almost immediately the specification then uses "parameter" in a way that means "the value of the variable." See page 9, lines 15 and 21, where "selectable parameters" or "selecting the parameters" only make sense if read as "selectable values of the parameters" or "selecting the values of the parameters." This second use of the word "parameter" is not a normal usage, but Appellants may be their own lexicographers.

This dual usage creates confusion in the specification and in the claims. It appears that Appellants are using "parameter" to mean both "the variable" (e.g., claim 1, line 3) and "the value of the variable" (e.g., claim 1, line 7) in the claims. As we are unable to determine with certitude which particular

meaning the word "parameter" is to be given when used in the claims, we are not able to determine the scope of the claims. The record before us does not mention nor address this in any way. Therefore, we request that the Examiner take appropriate steps to address this issue.

Accordingly, we *remand* for consideration of this issue.

II. Whether A Rejection Of Claims 1-14, 25-37, and 39-40 Under 35 U.S.C. § 112 Is Appropriate.

Independent claims 1, 35, and their dependent claims recite or depend from claims that recite, "providing a . . . parameter." We have reviewed Appellants' disclosure and do not find a clear indication of what corresponding acts described in the specification Appellants intend this language to cover.

The record before us does not mention nor address this in any way. Therefore, we request that the Examiner take appropriate steps to address this issue.

Accordingly, we *remand* for consideration of this issue.

III. Whether A Rejection Of Claims 15-24 and 38 Under 35 U.S.C. § 112 Is Appropriate.

Independent claim 15 and its dependent claims recite or depend from claims that recite numerous "means for providing." We have reviewed Appellants' disclosure and do not find a clear

indication of what corresponding structure described in the specification Appellants intend this language to cover.

The record before us does not mention nor address this in any way. Therefore, we request that the Examiner take appropriate steps to address this issue.

Accordingly, we *remand* for consideration of this issue.

IV. Whether A Rejection Of Any Of Claims 1-40 Under 35 U.S.C. § 112 Is Appropriate.

Given the complexity of this issue, we restrict our discussion to independent claim 1 and leave it to the Examiner to take appropriate steps with respect to the remaining claims.

Claim 1 recites three steps, all of which contain language that raises concerns about the certainty of its meaning. However, for purposes of this discussion, we will make assumptions about the meaning (or meanings) and then discuss the issues raised under 35 U.S.C. § 101.

In the specification at pages 9-10, Appellants describe at a theoretical level the preliminary steps a user would take to define the flexible zones of the present invention. These steps occur prior to format time. See page 10 at lines 19-20. Assuming the claim language "providing a user area parameter" corresponds to the action of a user deciding to use the share

interval parameter (SI) at page 9, line 10. We make a similar assumption for the second "providing" step and further assume that "selecting the user area parameter and replacement area parameter" corresponds to the action of a user selecting values of these parameters at page 9, line 21. (We recognize this is a double assumption as we are also assuming the meaning of parameter to be the value thereof). With these assumptions as to the meaning of Appellants' claim 1, we arrive at a claim that covers establishing the two parameters and selecting values thereof with both of these being abstract steps that occur before any concrete steps (the formatting). If our assumptions are correct, then there is a question as to whether Appellants' claim 1 is directed to subject matter covered by 35 U.S.C. § 101.

We note that an argument may be made that claim 1 should instead be interpreted as covering the practical application of the results of the theoretical determination discussed above, the argument being that such a practical application recites statutory steps that occur during the formatting process itself. This formatting process is found in Appellants' specification at pages 23-26. The formatting includes 1) establishing a user area parameter storage location for defining . . ., 2) establishing a replacement area parameter storage location for defining . . .,

and 3) selecting and storing in the respective storage locations user area parameter and replacement area parameter values . . . thereby defining appropriate defect management. However, we also note that countering the above argument is the fact that in examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. ***In re Yamamoto***, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984). Finally, we note that Appellants are free to amend the claim(s) so that they must be interpreted as covering only the practical application.

The record before us does not mention nor address the above issue in any way. Therefore, we request that the Examiner take appropriate steps to address this issue.

Accordingly, we *remand* for consideration of this issue.

Conclusion

If reconsideration by the examiner does not promptly result in the withdrawal of all pending rejections, the examiner must return this application to the jurisdiction of the Board so that the appeal may be restored to its existing place in the order in which appeals are decided. In the event that the examiner returns this application to the jurisdiction of the Board following

reconsideration, a new appeal number will be assigned. However, a new appeal fee will not be required.

This application, by virtue of its Special status, requires ***immediate*** action by the examiner. *See* MPEP § 708.01(d). The Board of Patent Appeals and Interferences ***must*** be informed promptly of any action affecting the appeal in this case, including reopening of prosecution, allowance and/or abandonment of the application.

REMAND TO THE EXAMINER

MICHAEL R. FLEMING)
Administrative Patent Judge)
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JOSEPH F. RUGGIERO) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
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